

REQUEST FOR RECONSIDERATION
U.S. Application No.: 09/836,236

REMARKS

Claims 1-32 are all the claims pending in the application.

Obviousness-Type Double Patenting Rejection

On page 2 of the Office Action, in paragraph 3, claims 13-20 and 29-32 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2-17 of U.S. Patent No. 6,346,359.

The Examiner's Position

The Examiner indicates that claim 2 of the '359 patent recites a diazonium compound and a coupler of formula (1) which has a leaving group (L) at a coupling position, meeting the coupler of present claim 13 (and apparently present claim 29), and which will form a color upon reacting with the diazonium compound.

Also, the Examiner indicates that the coupler and diazonium compounds recited in claims 2-17 of the '359 patent meet the limitations of claim 14, which recites a recording material, wherein the coupling reaction is characterized by having a faster reaction rate constant than a coupler having a hydrogen group at the coupling position. While the reaction rate is not explicitly recited in the claims of the '359 patent, the Examiner asserts that because the leaving groups on the couplers as presently claimed are the same as coupler having groups recited in the '359 patent, the presently claimed reaction rate constant is inherently present in the '359 patent.

Applicants' Response

In response to this rejection, Applicants note that claims 13-20 were rejected for obviousness-type double patenting over the '359 patent in the Office Action of December 19,

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2002, and a Terminal Disclaimer was filed on March 19, 2003 in response thereto disclaiming the terminal part of any patent issuing from the present application that would extend beyond the expiration of the term of the '359 patent.

Since this Terminal Disclaimer operates against all the claims of the present application, not just the claims which were rejected in the December 19, 2002 Office Action, Applicants submit that the present rejection has already been overcome by the Terminal Disclaimer of record. Accordingly, withdrawal of this rejection is respectfully requested.

Allowed Claims

On page 5 of the Office Action, in paragraph 4, the Examiner indicates that claims 1-12 and 21-28 are allowed.

Applicants thank the Examiner for indicating that claims 1-12 and 21-28 are allowed. Based on the above remarks, Applicants submit that the other pending claims should be allowed as well, and thus allowance of this application is respectfully requested.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

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The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



Bruce E. Kramer
Registration No. 33,725

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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